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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/451,160	11/30/1999	STEVEN R. BOAL	80.142-002	8692

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EXAMINER
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MYHRE, JAMES W

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 12/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/451,160

**Applicant(s)**BOAL, STEVEN R. **Examiner**

James W Myhre

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 22-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 22-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Response to Request for Reconsideration***

1. The Request for Reconsideration filed on August 10, 2004 under 37 CFR 1.111 is sufficient to overcome the Philyaw et al (6,377,986) reference. Claims 1-18 and 2-47 remain pending and have been considered below.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 26, 28, 30-32, and 44 rejected under 35 U.S.C. 102(e) as being anticipated by Stewart (5,835,061).

Claims 26 and 44: Stewart discloses a system and method for distributing coupons, comprising:

- a. collecting device information about a client device (col 3, lines 56-60);
- b. associating a device ID with the device information at a main server (col 4, lines 1-3);
- c. selecting a coupon (promotional information) according to the device ID based on the device information and transmitting the selected coupon to the client system (col 8, lines 12-19).

Claim 28: Stewart discloses a method for distributing coupons as in Claim 26 above, and further discloses associating the device ID with a remote client system (col 4, lines 1-3).

Claim 30: Stewart discloses a method for distributing coupons as in Claim 28 above, and further discloses the client system submitting a request including the device ID to the server (col 4, line 66 – col 5, line 6).

Claim 31: Stewart discloses a method for distributing coupons as in Claim 30 above, and further discloses automatically including the device ID without intervention by the remote user (col 5, lines 34-39).

Claim 32: Stewart discloses a method for distributing coupons as in Claim 30 above, and further discloses the request is automatically transmitted without intervention by the user (col 5, lines 34-39).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Payne et al (5,715,314).

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Claim 24: Payne discloses a method for distributing and redeeming coupons, comprising:

- a. associating a Uniform Resource Locator (URL) with a coupon (advertising document URL)(col 5, lines 16-25);
- b. displaying the coupon to a user (col 5, lines 16-25); and
- c. invoking (accessing) the URL with a browser to enable the user to redeem the coupon (i.e. purchase the corresponding product)(col 5, lines 26-47).

While Payne discloses an advertising document being accessed by the user, it is not explicitly disclosed that the digital image is a coupon. The Examiner notes that a coupon is one form of advertising document and that the claim does not actually use the coupon, but merely indicates that the final step of invoking the URL with a browser will "enable the user to redeem the coupon". The Examiner considers this as the intended use of the invention, since no steps are shown in which the user actually redeems the coupon. Therefore, since Payne discloses that the advertising document contains information about the product to include the price which will be charged to the user, the advertising document performs the same function as a coupon (discloses a product and a normally discounted price for the product). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the advertising documents in Payne would include one or more of such electronic commerce image files as coupons, rebate forms, order forms, product images, etc. One would have been motivated to include a coupon as one type of advertising document

being displayed by Payne in order to provide the user with a discounted "best" price for the product.

While Payne does not explicitly disclose disabling access to the URL, Official Notice is taken that using Java applets to reset function keys to include the "Button" keys was well known prior to the present invention. In support of this Official Notice, the Examiner is providing several references (see Conclusion paragraph below) which discuss various methods to protect online images which include disabling the "right-click" function on the mouse so as to display a different message in place of the standard menu displayed by Windows and which include the Java code to implement such a function (The Examiner notes that the code is merely a standard "IF-THEN" statement which reads the input from the mouse and outputs a desired message in place of the standard menu message). Furthermore, Schreiber, which was filed within a few months of the oldest priority date claimed by the applicant, discloses that at that time it was already known in prior art to "use Java applets within web browsers to disable the menu that pops up when a user right clicks on a displayed image within his browser" (col 2, lines 37-40); thus, disabling the display and access to the URL by the user. Thus, it would have been obvious to disable the user's access to the URL of the coupon (digital image) by substituting a different message for the normal menu displayed when the user right-clicks on the image.

Claim 25: Payne discloses a method for distributing and redeeming coupons as in Claim 24 above, and further discloses selecting the coupon by clicking on the coupon (advertising document)(col 5, lines 16-47).

5. Claims 1-18, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Payne et al (5,715,314) in view of Stewart (5,835,061).

6. Claims 27, 29, 33-43, 45, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart (5,835,061) in view of Payne et al (5,715,314).

The Examiner notes that the claim set contains two inventions. Independent Claim 24 is directed towards a method of disabling access to a link prior to redeeming a coupon. Independent Claim 26 is directed towards a method of selecting a targeted coupon based on the client device's information and ID. Claims 1 and 22 add the targeting method steps of Claim 26 to the access disabling and redemption steps of Claim 24. The two inventions are further limited by matching dependent claims. In order to compress prosecution of the pending claims, the Examiner will group the rejections of these matching dependent claims together.

The Examiner contends that it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the references. One would have been motivated to include Stewart's method of selecting targeted coupons with Payne's method of disabling access to a link prior to redeeming the coupon or to include Payne's method of disabling access to a link prior to redeeming a coupon with Stewart's method of selecting targeted coupons in order to have a complete coupon processing system in which targeted coupons are selected, issued, protected, and then redeemed by accessing a link whose access had been disabled.

Claim 1: Payne discloses a method for distributing and redeeming coupons as in Claim 24 above, but does not explicitly disclose the steps of selecting a targeted coupon based on the device ID and information as in Claim 26. However, as discussed above, Stewart discloses these steps. Therefore, it would have been obvious to include the targeted coupon selection and issuance method of Stewart to Payne's redemption method. One would have been motivated to include the selection and issuance steps in order to have coupons to redeem.

Claims 2, 27, 45, and 46: Payne and Stewart disclose a method for selecting, distributing, and redeeming targeted coupons as in Claims 1, 26, and 44 above. Payne further discloses obtaining demographic information from the buyer the buyer's network address (Figure 2A, item 34 and col 5, lines 26-47). Payne further discloses that the product being bought may be "hard goods, i.e. durable products as opposed to information products" (col 4, lines 56-60). In the United States, it is required by the United States Postal Service that all addresses have a zip code. Therefore, based on Payne's disclosure of collecting address information when taken along with the disclosure of purchasing hard goods (which would require sending the purchased hard goods to the user) and Stewart's disclosure of the User ID identifying the location of the user, plus in one embodiment also collecting demographic information about the user (and prior art in which "the user is prompted to key in his area code and exchange prefix" (col 2, lines 10-12)), it would have been obvious to one having ordinary skill in the art at the time the invention was made to obtain demographic information to include a postal zip code from the user of the client device in Payne or Stewart. One would



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have been motivated to obtain this information in order to allow the systems to better target the selection of the coupon for redemption at local merchants and to enable the system to mail additional information (e.g. more coupons or the actual product) to the user as discussed in Payne.

Claim 3: Payne and Stewart disclose a method for selecting, distributing, and redeeming targeted coupons as in Claim 1 above, and Stewart further discloses associating the device ID with a remote client system (col 4, lines 1-3).

Claims 4 and 29: Payne and Stewart disclose a method for selecting, distributing, and redeeming targeted coupons as in Claims 3 and 28 above, and Stewart also discloses the buyer's device being able to print documents (e.g. coupons)(col 2, lines 40-42). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to print the coupon at the client device. One would have been motivated to print the coupon in order to allow the user of the device to redeem the coupon at a "brick-and-mortar" store.

Claim 5: Payne and Stewart disclose a method for selecting, distributing, and redeeming targeted coupons as in Claim 3 above, and Stewart further discloses the client system submitting a request including the device ID to the server (col 4, line 65 – col 5, line 6).

Claim 6: Payne and Stewart disclose a method for selecting, distributing, and redeeming targeted coupons as in Claim 5 above, and Stewart further discloses automatically including the device ID without intervention by the remote user (col 5, lines 34-39).

Claim 7: Payne and Stewart disclose a method for selecting, distributing, and redeeming targeted coupons as in Claim 5 above, and Stewart further discloses the request is automatically transmitted without intervention by the remote user (col 5, lines 34-39).

Claims 8 and 33: Payne and Stewart disclose a method for selecting, distributing, and redeeming targeted coupons as in Claims 7 and 32 above, and Stewart further discloses the transmitting step occurs at predetermined intervals (beacon signal)(col 4, lines 10-19).

Claims 9, 10, 34, and 35: Payne and Stewart disclose a method for selecting, distributing, and redeeming targeted coupons as in Claims 3 and 28 above, but none of the references explicitly disclose that the graphical user interface on the client device uses icons which may also flash to indicate the availability of new coupons. However, Official Notice is again taken that the use of icons, graphics, colors, animation, etc. to attract the viewer's attention on graphical user interfaces is well known in the computer arts, and their use would have been obvious to one having ordinary skill in the art at the time the invention was made. In support of this Official Notice, the Examiner previously provided excerpts from two HTML textbooks from 1996 to show that, not only was it well known to "flash" parts of a web page to attract the user's attention, but that the "Blink" command was also one of the standard commands in the programming language (Graham, "The HTML Sourcebook, Second Edition, A Complete Guide of HTML 3.0", 1996, pp 233-234)(Lemay, "Teach Yourself Web Publishing with HTML 3.0 in a Week", 1996, pp 183). Therefore, one would have been motivated to use icons, flashing or

otherwise, to notify the user of the Payne and Stewart systems in order to attract their attention more easily.

Claims 11, 22, and 36: Payne and Stewart disclose a method for selecting, distributing, and redeeming targeted coupons as in Claims 3, 24, 26, and 28 above, and Payne further discloses using cryptographic methods to protect the data being transmitted between the buyer and seller (col 7, line 55 – col 8, line 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include encryption techniques in the Stewart system. One would have been motivated to encrypt the coupon data prior to transmitting the data over an unsecure network, such as the public switched telephone network as disclosed by Stewart, in order to prevent unauthorized interception of the data.

Claims 12 and 37: Payne and Stewart disclose a method for selecting, distributing, and redeeming targeted coupons as in Claims 11 and 36 above. While none of the references explicitly disclose that the client system will also encrypt the coupon data upon receiving the data from the remote server, Official Notice is again taken that it is old and well known within the data encryption arts to encrypt data using a plurality of encryption methods in order to provide a higher level of security to the data. In support of this Official Notice, the Examiner previously provided Chapter 15 from a cryptography textbook from 1996 to show that not only was double encryption a well known method to further protect data, but triple encryption and other multiple encryption schemes were also well known and used in the art (Schneier, "Applied Cryptography, Second Edition", 1996, pp 357-368). Therefore, it would have been obvious to one

having ordinary skill in the art at the time the invention was made to use a local encryption method to further encrypt and protect the encrypted data received from the remote server. One would have been motivated to further encrypt the coupon data locally in this manner in order to prevent unauthorized disclosure of the selected coupons to other persons who may use the client device (e.g. other family members, co-workers, etc.).

Claims 13, 23, and 38: Payne and Stewart disclose a method for selecting, distributing, and redeeming targeted coupons as in Claims 12, 22, and 37 above, and Payne further discloses the client device decrypting the advertising document (col 7, line 55 – col line 2). Furthermore, Stewart discloses the buyer's device being able to print documents (e.g. coupons)(col 2, lines 40-42). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to print the coupon at the client device. One would have been motivated to print the coupon in order to allow the user of the device to redeem the coupon at a "brick-and-mortar" store.

Claims 14 and 39: Payne and Stewart disclose a method for selecting, distributing, and redeeming targeted coupons as in Claims 3 and 28 above. Both Payne and Stewart also disclose displaying at least a portion of the advertisement (coupon) to the user of the client device (Payne, col 5, lines 26-27) (Stewart, col 4, lines 5-7 and col 7, line 12-20).

Claims 15 and 40: Payne and Stewart disclose a method for selecting, distributing, and redeeming targeted coupons as in Claims 14 and 39 above, and Payne further discloses selecting an advertisement (advertising document) in which the

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products are arranged in categories and subcategories (domains) and the selection of the coupon is based on the matching category/subcategory (col 5, lines 7-11).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the available coupons and advertisements in Payne and Stewart into categories and subcategories and to make the selection from the appropriate category/subcategory. One would have been motivated to sort the advertisements and coupons in this manner in order to facilitate the locating and retrieval of the desired coupons/advertisements.

Claims 16 and 41: Payne and Stewart disclose a method for selecting, distributing, and redeeming targeted coupons as in Claims 2 and 28 above, and Payne further discloses tracking the user's actions on the client device and maintaining a database of advertising documents, selected, and redeemed by the user (col 6, line 60 – col 7, line 14 and col 8, lines 33-37). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to track and store the user's actions on the client device in Payne and Stewart. One would have been motivated to track the user's actions in this manner in order to allow the advertiser/coupon issuer to better assess the effectiveness of their marketing campaign.

Claim 17 and 42: Payne and Stewart disclose a method for selecting, distributing, and redeeming targeted coupons as in Claims 16 and 41, and Payne further discloses determining the identity of the advertiser/coupon provider (merchant computer identifier and merchant account identifier, col 5, lines 30-47). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to

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determine the identity of the advertiser/coupon issuer in Payne and Stewart. One would have been motivated to identify the advertiser/coupon issuer in order to determine to whom the marketing fees would be charged and to enable the system to provide feedback to the marketer.

Claims 18 and 43: Payne and Stewart disclose a method for selecting, distributing, and redeeming targeted coupons as in Claims 16 and 41 above, and Payne further discloses encrypting the files prior to transmission across unsecure networks. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to encrypt the user event (history) files in Stewart. One would have been motivated to encrypt this data in order to prevent unauthorized disclosure to other users of the client device (e.g. other family members or co-workers).

### ***Response to Arguments***

7. Applicant's arguments with respect to the cited references have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Lemon et al (4,674,041) discloses a system and method for distributing coupons to remote terminals using the identification number of the remote terminal.

b. Schull (5,509,070) discloses a system and method for protecting non-executable data using an encrypted target ID, such as the serial number of the CPU.

c. Logan et al (5,761,683) discloses a system and method for changing the function of the right-button mouse click.

d. Stewart (5,969,678) is a continuation of the reference used in the rejection above.

e. Tracy et al (5,979,757) discloses a system and method for presenting information to a portable terminal using URL information based on the terminal identification.

f. Kamakura et al (6,047,310) discloses a system and method for distributing coupons to users based on the user's demographics to include address and zip code.

g. Swartz et al (6,687,346) discloses a system and method for presenting coupons to a user based on the terminal identification and user demographics.

h. Web Design Help, vBulletin, April 13-5, 2001, discusses various ways to disable the right-button mouse click to prevent downloading (or printing) of online images. Several respondents provide short Java programs using IF-THEN statements which accomplish this feature.

i. ImageSafe, "ImageSafe – Image copy protection" discloses a product which protects online images and documents by disabling the right-button mouse click feature.

j. Purdue News "New software protects ownership of Web images", discloses several method of protecting online images to include electronic watermarks and a product called "Copysight".

k. Lindholm and Yellin, "The Java Virtual Machine Specification, Second Edition", discloses the "if<cond>" programming command which can be used by a variety of programming languages to designate a desired action when a certain action, such as the activation of the right mouse button, takes place.

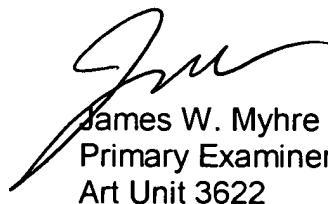
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached Monday through Thursday from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.



JWM  
December 8, 2004



James W. Myhre  
Primary Examiner  
Art Unit 3622